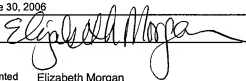



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|---|--|--|--|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 068986.0103 | |
| I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office via the PTO's Electronic Filing System on the date shown below. Date: <u>June 30, 2006</u> Signature: <u></u> Typed or printed name: <u>Elizabeth Morgan</u> | | Application Number 09/817,009 Filed 3/24/2001 First Named Inventor Mark B. Lyles Art Unit 1639 Examiner Jon D. Epperson | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | | |
| I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number: <u>33,790</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ | | <u></u> Signature Bruce W. Slayden II Typed or printed name _____ 512.322.2606 Telephone number _____ June 30, 2006 Date _____ | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |
| <input type="checkbox"/> *Total of _____ forms are submitted. | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|-----------------------|---|
| In re Application of: | Mark B. Lyles |
| Serial Number: | 09/817,009 |
| Filed: | March 24, 2001 |
| Group Art Unit: | 1639 |
| Examiner: | Epperson, Jon D. |
| Title: | HIGH THROUGHPUT SCREENING ARRAY CONTAINING POROUS MATERIAL |

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed February 23, 2006. At the time of the Final Office Action, Claims 1, 3, 4, 7-10, 13, and 14 were pending in this Application. Claims 1, 3, 4, 7-10, 13, and 14 were rejected.

Claims 1, 3, 4, 7-10, 13, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Glazer et al.'s "*High Surface Area Substrates for DNA Arrays*" in Materials Research Society Symposium Proceedings ("Glazer.") and U.S. Patent 5,629,186 issued to Robert D. Yasukawa et al. ("Yasukawa"). Applicant respectfully traversed and submitted the cited art combinations, even if proper, which Applicant did not concede, did not render the claimed embodiment of the invention obvious.

Claims 1, 3, 4, 7-10, 13, and 14 were also rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,959,098 issued to Martin Goldberg *et al.* ("Goldberg") and Yasukawa. Applicant respectfully traversed and submitted the cited art combinations, even if proper, which Applicant did not concede, did not render the claimed embodiment of the invention obvious.

Claim 1 was amended to emphasize that the presently claimed embodiment of the invention is directed to a "high throughput screening array," not just to an array. In furtherance of this emphasis, Applicant amended Claim 1 to specify that the porous material has a mean pore diameter greater than about 10 microns, and consists of a density of 6 pounds per cubic foot or higher. These limitations relate to the high throughput characteristic of the claimed array. Neither Glazer nor Yasukawa disclose and/or suggest such a porous material for a high throughput array. For example: (1) Glazer teaches, "[p]ore dimensions were measured directly from the images as 0.1 to 0.3 microns," and (2) Yasukawa teaches nothing in relation to "pore dimensions." The Examiner notes that Yasukawa teaches silica fibers having "diameters between about 5 to 20 μm ." This statement does not teach a porous material having a "mean pore diameter of at least about 10 microns."

And as noted, the presently claimed embodiment of the invention is directed to a high throughput screening array material having a density of "6 pounds per cubic foot or higher." It is respectfully submitted that a full reading of Yasukawa leads one of ordinary skill in the

art to the conclusion that the Yasukawa material must always include a portion having a density ranging from about "3.5 and 5.5 pounds/ft³." Indeed, Yasukawa states in the "Summary of the Invention":

The matrix is characterized by . . . (b) a density of between about 3.5 and 5.5 pounds/ft³ . . .

(Col. 1, lines 29-30). As shown below, and previously pointed out to the Examiner, Yasukawa's material always has densities less than or equal to 5.5 pounds/ ft³:

The slurry is allowed to settle under conditions effective to produce a fiber block having a selected fiber density between about 3.3 and 5.3 pounds/ft³.

(Col. 2, lines 9-11)

The target density of the matrix after drying is between 3.3 to 5.3 pounds/ft³.

(Col. 8, lines 7-9)

The matrix is then heated to progressively higher temperature . . . until a desired fusion and density are achieved, the target density being between 3.5 and 5.5 pounds/ft³.

(Col. 8, line 65 - Col. 9, line 3)

The target density of the matrix after drying is between 3.3 to 5.3 pcf.

(Col. 14, lines 50-51)

The dried matrix was sintered about 2200°F . . . to achieve fired densities between 3.3 to 5.5 pcf.

(Col. 14, lines 53-56)

And Yasukawa's Claim 1 claims:

"(b) a density of between about 3.5 and about 5.5 pounds/ft³ . . ."

Yasukawa's Claim 6, dependent on Claim 1, claims:

... prepared by heating a fiber block ... having a density between about 3.3 and 5.3 pounds/cubic feet ...

And finally, as previously referred to by the Examiner, Claim 8 states:

8. The matrix of claim 1 having in one matrix dimension, a matrix **gradient progressing between a selected density 3.5-5.0 pounds/ft³** to a selected density 5.5 to 12 pounds/ft³.

Thus, Yasukawa teaches that the material must include a matrix having a density of 3.5 to 5.5 pounds/ft³, and preferably the entire matrix has a density ranging from 3.5 to 5.5 pounds/ft³. Even Claim 8, previously referenced by the Examiner, requires that the matrix contain a specific portion having a density at or below 5.5 pounds/ft³. Indeed, Claim 8, while not even supported by the Yasukawa's specification, is dependent on Claim 1 which requires "(b) a density of between 3.5 and 5.5 pounds/ft³." Whereas, the claimed embodiment of the invention is directed to a porous material having a density which "consists of a density of 6.0 pounds per cubic foot and higher." Consequently, the cited art does not teach all of the elements of the claimed invention. A *prima facie* case of obviousness has not been established.

The Examiner states in support of his obviousness rejection for combining Glazer and Yasukawa, that Yasukawa discloses a density of "about 5.5 pounds/ft³" and would read on about a density "6-6.5 pounds/ft³." The Examiner's belief is misplaced and the Applicant amended Claim 1 to help further distinguish Yasukawa. The presently claimed material "**consists** of a density of about 6 pounds per cubic foot and higher." Thus, materials having densities below 6 pounds per cubic foot are expressly excluded by this language. As taught repeatedly by Yasukawa, Yasukawa requires that its material ALWAYS include a portion having a density of 3.5 to about 5.5 pounds per cubic foot. The range cited by the Examiner for Yasukawa (up to 12 pounds per cubic foot) relates to a material with a "**gradient density**", that is, it must have portions with a density as low as 3.5 to 5.5 pounds per cubic foot. The presently claimed material does not cover a material with a portion having a density as low as 3.5 to 5.5 pounds per cubic foot and the Applicant does not think such a low density material would even function to provide the presently claimed invention and thus, the reason

for the greater than 6 pounds per cubic foot limitation. The Examiner has failed to establish a *prima facie* case of obviousness.

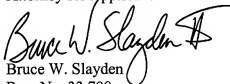
Claims 1, 3, 4, 7-10, 13, and 14 were also rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,959,098 issued to Martin Goldberg et al. ("Goldberg") and Yasukawa. Yasukawa, for the reasons stated above, does not teach the presently claimed subject matter, e.g., a material "consisting of" a density of "6 pounds per cubic foot and higher." And Goldberg does not fill this gap. Thus, the Examiner has failed to establish a *prima facie* case of obviousness. Consequently, Applicant requests withdrawal of the obviousness rejections which fail to establish a *prima facie* case of obviousness. Allowance of Claims 1, 3, 4, 7-10, 13 and 14 is requested.

CONCLUSION

Applicant submits this Pre-Appeal Brief Request for Review, Petition for Two Month Extension of Time, and Notice of Appeal. The Commissioner is authorized to charge \$250.00 to cover the filing fee for the Notice of Appeal and \$225.00 for the extension fee to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this request that may be cleared up in a telephone conversation, please contact Applicant's attorney, Bruce W. Slayden II, at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant


Bruce W. Slayden
Reg. No. 33,790

Date: June 30, 2006

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2606
512.322.8383 (fax)